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Docket 80724F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Kenneth A. Parulski

LEASING A CONFIGURED
CAMERA SYSTEM

Serial No. 09/534,471

Filed March 24, 2000

Group Art Unit:

Examiner:

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

June Carfagna

June Carfagna

April 11, 2007

Date

Mail Stop APPEAL BRIEF-PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA. 22313-1450

Sir:

APPEAL BRIEF TRANSMITTAL

Enclosed herewith is Appellants' Third Supplemental Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

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Examiner:

I hereby certify that this correspondence was sent by
facsimile transmission to the United States Patent and
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June Carfagna
June Carfagna

April 11, 2007
Date

THIRD SUPPLEMENTAL APPEAL BRIEF PURSUANT TO 37 C.F.R.



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THIRD SUPPLEMENTAL APPELLANT'S BRIEF ON APPEAL

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-6 and 9-19 which was contained in the Office Action mailed January 13, 2003.

A timely Notice of Appeal was filed April 9, 2003.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1-6 and 9-19 are pending in the subject application. These claims have been rejected and are appealed. Claims 7 and 8 have been cancelled from the present application.

Appendix I provides a clean, double-spaced copy of the claims 1-6 and 9-19 on appeal.

Status Of Amendments

An initial Office Action was mailed on April 28, 2002. An amendment in response to the Office Action was mailed on July 23, 2002. A Notice of Non-response was mailed on October 10, 2002. An amendment in response to the Notice of Non-response was mailed on October 17, 2002. A final Office Action was mailed on January 13, 2003. A 116 Amendment in response to the Office Action was mailed on March 13, 2003. A Notice of appeal was mailed on April 9, 2003. An Advisory Action was mailed on April 7, 2003. An Appeal Brief was mailed on June 9, 2003. A Notification of Non-Compliance was mailed on August 25, 2003. A response to the Notification of Non-Compliance was mailed on September 10, 2003. A Supplemental Appeal Brief was mailed on September 9, 2003. A Notice of Defective Appeal Brief was mailed on June 6, 2006. A Second Supplemental Appeal Brief was filed on July 5, 2006. A Notice of Non-

Compliance with 378 CFR 1.192 (c) was mailed on 9/29/2006. A response under 37CFR 1.116 was mailed on October 30, 2006 canceling claim 8. The amendment was entered pursuant to an Advisory Action dated 11/30/2006. A Notification of Non-Compliant Appeal Brief was mailed on 3/12/2007. The claims stand as indicated in Appendix I.

Summary Of The Invention

The present invention is directed to a configured camera and a method for a customer leasing a configured camera system (See Fig. 1) that includes a camera and services to be provided with respect to a configured camera 80. Fig. 2 illustrates a flow chart of a typical operation of the system and page 5, line 6 to page 6, line 9 provides an over view of the present invention. The method includes paying for the lease of a configured camera and includes the steps of providing an electronic database 44 of information that describes a plurality of different configured camera systems. Each of the camera systems having different features and services that can be selected by a customer over a communication network 36 and displayed at a customers remote location 10. The customer selects the desired components and services to be provided and completes a lease agreement that results in the providing of goods and/or services with respect to images captured by the camera 80. A payment identifier is provided which identifies an account at the database 44 for use in providing the goods and/or services with respect to images that are captured by the camera 80.

Issues For Review By The Board

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 17-19 are unpatentable under 35 USC § 102(b) as being anticipated by US Patent 5,819,126 to Kitagawa et al.
2. Whether claims 1-6 and 9-16 are unpatentable under 35 USC § 103(a) over the admitted prior art and in view of Kitagawa et al.

Grouping Of Claims

- | | |
|------------|---|
| Group I: | Claims 17, 18 and 19 stand together as a group. |
| Group II: | Claims 1 is a group. |
| Group III: | Claims 2 and 3 stand together as a group. |

- Group IV: Claims 4, 5, 6 and 16 stand together as a group.
- Group V: Claims 9, 10, 11, 12, 13, 14, and 15 stand together as a group.

Arguments

I. Statement on Grouping of Claims

Appellant has grouped rejected claims 1-6 and 9-19 into Groups I-V, as specified above. The claims of one Group do not stand or fall with the claims of another Group.

The Group I claims are directed to a camera for capturing images to be provided to a service provider. The camera includes means for capturing and storing images and firmware memory for storing a service identifier, which identifies a service provider account. The service provider account specifies services to be provided by the service provider. The Group I claims further define a distinguishing feature directed to a camera for capturing images to be provided to a service provider. The cited prior art does not teach or suggest these features.

The Group II claim is directed to a method for a customer to lease a configured camera system including a camera and services for such configured camera system, and paying for the lease of such configuration camera system. There is no teaching or suggestion of leasing a camera in Appellant's admitted prior art (AAPA) reference as taught and claimed. Further, there is no suggestion in the AAPA reference to do so. There is also no teaching or suggestion of any type of leasing arrangement in the cited reference.

The Group III claims include the features of claim 1, and further define a distinguishing feature of selecting programs which depict the functionality of the desired features. The prior art cited fails to teach or suggest at least the providing of this program in combination with the various other elements as taught and claimed by Appellant.

The Group IV claims include the features of claim 2 or 9 and further define a distinguishing feature of capturing the image using the configured camera and forwarding such image for storage to a designated location. The cited prior art does not teach or suggest this feature.

The Group V claims are directed to a method for leasing of a camera system wherein a customer selects the desired service and completes a lease agreement and provides a payment identifier specifying an account to be debited for a selective service, and also establish a service user account that

specifies the selected service that is being used and storing the camera and service identifier corresponding to the user account and sending the camera to the designee of a customer. The Group V claims also set forth providing an electronic database of information that describes at least one camera system which has a service that can be selected by the customer via a digital communication system with respect to images captured by the camera. The Group V claims further define a distinguishing feature of providing of a payment identifier which specifies the account to be debited with respect to the service that is to be provided by the camera and the providing of specific services that are to be provided with respect to such captured images. The cited prior art does not teach or suggest these features.

II. The Rejection

Group I-Claims 17 and 19

- A. The rejection of claims 17-19 under 35 USC § 102(b) as being clearly anticipated by Kitagawa et al.

The Examiner has not provided any statements in the rejection as to why Kitagawa et al. teaches or suggests the invention as set forth by independent claim 17 other than the statement that it is clearly anticipated. In the first Official Action dated April 23, 2002, the Examiner merely stated that claim 7 and 17-19 are rejected under 35 USC § 102(b) as being clearly anticipated by Kitagawa et al. No supporting arguments were presented. The Examiner in the final rejection dated January 13, 2003, again, rejected claims 17-19 under 35 USC § 102(b) as being anticipated by Kitagawa et al. in paragraph 5. Hereagain, no further statements for the basis of the rejection were directly made as to why the claims were obvious. However, the Examiner in paragraph 9 did respond to Appellant's previous arguments with respect to claim 17, stating "A recitation of the intended use of a claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim."

In order to properly reject a claim under 35 USC § 102(b), each and every element must exist in the same reference. The Examiner has failed to illustrate how the cited reference anticipates the present invention. Appellant respectfully submits there are numerous elements in the claimed invention that are missing from the cited reference.

More particularly, independent claim 17 is directed to a camera for capturing images to be provided to a service provider. The camera includes means for capturing and storing images and firmware memory for storing a service identifier which identifies a service provider account. The service provider account specifies services to be provided by the service provider.

Claim 17 also provides means for providing the captured images and the service identifier to the service provider. Thus, it is clear that the camera

has firmware memory that stores a service provider identifier and also provides means for providing of the captured images and the service identified to a service provider. These are structural limitations that are required of the claim.

The Kitagawa et al. reference is directed to simply recording information onto photographic film or on to an IC memory provided on a film cartridge. The Kitagawa et al. reference fails to teach; (1) firmware for storing a service identifier; (2) that the service identifier identifies a service provider account; and (3) means for providing the captured images and the service identification to the service provider. Thus, there are at least three specific limitations in claim 17 that are not taught or suggested by Kitagawa et al. By definition, the Kitagawa et al. reference could not anticipate claim 17. As previously set forth, the service identifier identifies the service provider account. Additionally, the service provider account specifies services to be provided by the service provider. Further, as is well established, functional limitations must be considered and evaluated as with any other limitations. See MPEP 2173.05(g).

In the present invention, the service identifier is used to identify the service provider account. There is no such teaching or suggestion for providing such a service in Kitagawa et al. In the present invention, the service provider account specifies the goods and/or services to be provided. There is no teaching or suggestion providing this, as with the other limitations in the cited Kitagawa et al. reference. Thus, applicant respectfully submits that the rejection under 35 USC § 102(b) cannot be maintained and therefore should be withdrawn.

Since claims 18 and 19 depend on independent claim 17, these claims are also patentably distinct over Kitagawa et al.

In summary, it is respectfully submitted that the present invention as set forth by claims 17-19 are patentably distinct over the cited Kitagawa et al. reference.

Group II - Claim 1 B. The Examiner has rejected claims 1-6 and 9-16 under 35 USC § 103(a) as being unpatentable over the admitted prior art described in the specification in view of Kitagawa et al.

First, applicant would like to first clarify what applicant has admitted as being the prior art. In the background of the invention, applicant has admitted that there exists a Dell Internet site and that using this site, different configurations of a Dell computer can be purchased. The customer can buy a "standard" configuration of a particular model computer, or can instead select various options. The Dell reference relates to ordering selected equipment over the Internet, but the equipment that is produced is defined entirely by the user's selection from a pre-existing menu. The user does not upload personal data or digital images that are used to personalize the computer or the merchandise. In the present invention, the information provided by the user is used for establishing what is done with respect to images captured by the camera. There is nothing to indicate or suggest that anything that is produced by the Dell computer is later used.

Further, a computer is totally apart from an image capture device. A computer such as that purchased from Dell is merely used for typical manipulation of a software program. This is in contrast to a camera which is designed to capture images and the captured images are used for producing image products such as photographic prints.

Independent claim 1 is directed to a method for a customer leasing a configured camera system including a camera and services for such configuration camera system and paying for the lease of such configuration camera system. There is no teaching or suggestion of leasing a camera in the Dell reference as taught and claimed. Further, there is no suggestion in the Dell reference to do so. There is also no teaching or suggestion of any type of leasing arrangement in the Kitagawa et al. reference.

The Examiner in the final rejection dated January 13, 2003, on page 3, states that the admitted prior art as described by applicant, "clearly anticipates all of the substantive elements of the instant invention with regard to a method of

sales of customized products, except for disclosing the particular customized product being offered for sale and selected/created by the customer in the manner of computer systems at dell.com is a camera system being sold for a one-time use (i.e. lease)". Everywhere supplied.

In this regard, applicant does not understand what the Examiner means by "anticipates all of the substantive elements of the instant invention....". The present invention is a combination of all of the elements set forth in the independent claim, all of which are important to the present invention. One of the elements of the present invention is that the customer selects desired components and services to provide the configured camera system and completing the lease agreement and providing a payment identifier as specified in an account to be debited to pay for the configured camera system. There is no teaching or suggestion in either of the references cited of providing a payment identifier that specifies an account to be debited for the payment of the configured camera system. Nor, does the prior art teach or suggest the sending of the camera to a designee of the customer and establish a service user account as specified as selected services that the designee can use with respect to the images captured by the camera. As previously discussed, the service user account relates to what is to be done with respect to the images captured by the camera. There is no teaching or suggestion of this lease concept.

The Examiner apparently has tried to argue in the rejection, that a one-time use camera is such a lease. Applicant respectfully submits that the purchase of a one-time use camera is not a lease as set forth by the present invention. First, a one-time use camera is purchased by an individual and is returned to a variety of different photofinishing labs for the development of the film contained therein for producing prints. The fact that they may be refurbished in some fashion does not admit that it is a lease or even suggests that it is a lease. Further, there is no setting up of any account as set forth by independent claim 1 and therefore, the leasing could not be accomplished by the one-time use cameras.

With respect to the Dell system, it simply provides a configured computer in accordance with selections available to the user. There is nothing that

teaches or suggests that the output of the computer, if there is any, be sent to a provider for providing selected services with regard to the use of computer. In the present invention, the use of a configured camera results in the providing of selected services designated with respect to a user account. There is no teaching or suggestion in the Dell system or Kitagawa et al. of providing such a feature.

Furthermore, in order to provide an appropriate combination, there must be some motivation in which to combine the Dell reference with respect to the Kitagawa et al. reference. The Examiner in paragraph 10 of the Official Action dated January 13, 2003, in response to applicant's arguments setting forth that there is motivation, has stated ... "In this case, the teaching of Dell is merely for the selling of customized products over the Internet. The selling of non-customized cameras over the Internet is admitted to be conventional, and Kitagawa et al. disclose a customized camera having the same particular features and usage as that of the instant invention. Therefore, the motivation to combine is simply to sell cameras such as that of Kitagawa et al. in the customized online manner of Dell rather than in the conventional online manner." However, there is no teaching or suggestion for providing a customization of cameras. At most, the combining of Dell with Kitagawa et al. would teach the purchasing of custom cameras over the Internet. The present invention is distinctly different for the reasons previously set forth. The prior art fail to disclose a method for leasing a configured camera, a payment identifier that specifies an account, and that the account specifies the selected service that the designee can use with respect to the images captured by the camera. Therefore, the cited art could not anticipate or render obvious the present invention. Also, there would be no motivation to combine the cited references due to the distinct products and features provided by each.

Group III claims 2 and 3

C. Rejection of claims 2 and 3 under 35 USC § 103(a).

Claim 2 includes many of the same features of claim 1 and is therefore patentably distinct from the same reasons. Claim 2 includes the

limitation of leasing a camera. Neither the Dell or Kitagawa et al. references teach or suggest leasing a camera as taught and claimed by Appellant. Secondly, there is no teaching or suggestion of providing a payment identifier that specifies an account to be debited for the payment of the configured camera system as taught and claimed by Appellant. Nor does the prior art teach or suggest establishing a user account that specifies a service elective for that designee and storing in the camera a service identifier to correspond to the service user account. Claim 2 further includes the limitation of selecting programs which depict the functionality of the desired features. For example, the present invention allows the program to depict the functionality of red-eye removal by illustrating an image both before and after of the desired functional feature of red-eye removal. There is no teaching in any of the prior art cited, the providing of this program in combination with the various other elements as taught and claimed by Appellant.

Group IV - Claims 4, 5, 6 and 16

D. Rejection of claims 4, 5, 6 and 16 under 35 USC § 103(a).

These claims are dependent upon independent claims 2 or 9 respectively, but include the additional limitation of capturing the image using the configured camera and forwarding such image for storage to a designated location. The cited prior art does not teach or suggest this feature and thus, it could not render obviousness the feature set forth in these claims.

Group V - Claims 9-15

E. Rejection of claims 9-15 under 35 USC § 103(a).

Claim 9 is another independent claim upon which claims 10-15 depend at least ultimately. Claim 9 is also directed to a method for leasing of a camera system wherein a customer selects the desired service and completes a lease agreement and provides a payment identifier specifying an account to be debited for a selective service, and also establish a service user account that specifies the selected service that is being used and storing the camera and service identifier corresponding to the user account and sending the camera to the

designee of a customer. Claim 9 further sets forth of providing an electronic database of information that describes at least one camera system which has a service that can be selected by the customer via a digital communication system with respect to images captured by the camera. The cited prior art fails to teach or suggest the claimed invention for the reasons previously set forth with regard to independent claims 1 and 2. Neither of the two cited references teach or suggest the providing of a payment identifier which specifies the account to be debited with respect to the service that is to be provided by the camera nor the providing of specific services that are to be provided with respect to such captured images.

Accordingly, it is respectfully submitted that neither of the cited references teach or suggest the claimed features of claim 9. Thus, claim 9 and its dependent claims are also patentably distinct over the cited references.

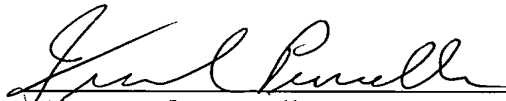
Summary

In summary, Appellant respectfully submits that the present invention is patentably distinct over the prior art.

Conclusion

For the above reasons, Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1-6 and 9-16.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Frank Pincelli", written over a horizontal line.

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Enclosures

Appendix I - Claims on Appeal

1. A method for a customer leasing a configured camera system including a camera and services for using such configured camera system and paying for the lease of such configured camera system, comprising the steps of:

(a) providing an electronic database of information describing a plurality of differently configured camera systems which have different features and services that can be selected by the customer via a digital communications network;

(b) displaying at the customer's location remote from the electronic database various components of the camera system that can be combined into the configured camera system;

(c) the customer selecting desired components and services to provide the configured camera system and completing a lease agreement and providing a payment identifier specifying an account to be debited to pay for the configured camera system; and

(d) sending the camera to a designee of the customer and establishing a service user account that specify the selected services that the designee can use with respect to the images captured by said camera.

2. A method for a customer configuring a camera and paying for the lease of such configured camera, comprising the steps of:

(a) providing an electronic database of information describing a plurality of differently configured cameras which have different features that can be selected by a customer via a digital communications network and programs which depict the functionality of such features;

(b) displaying at the customer's location remote from the electronic database various configuration features of cameras that are available and selecting programs which depict the functionality of desired features;

(c) the customer selecting various features to provide a desired configuration of a camera and providing a payment identifier specifying an account to be debited to pay for the configured camera; and

(d) sending the configured camera to a designee of the customer.

3. The method of claim 2 further including the step of the customer selecting various services to be used in conjunction with the configured camera and paying for such services.

4. The method of claim 2 further including the step of:

(e) capturing an image using the configured camera; and

(f) forwarding such image for storage to a designated location.

5. The method of claim 4 further including sending stored images to a printer for making a visual image of at least one of the stored images and delivering prints of the stored image to one or more designated recipients.

6. The method of claim 4 including providing at least one of the stored images on a computer program product and delivering such computer program product to a designee.

9. A method for a customer leasing a camera system including a camera and services for using such camera system and paying for the lease of such camera system, comprising the steps of:

(a) providing an electronic database of information describing at least one camera system which has services that can be selected by the customer via a digital communications network with respect to images captured by said camera;

(b) displaying at the customer's location remote from the electronic database the various services of the at least one camera system that can be selected by the customer;

(c) the customer selecting desired services and completing a lease agreement and providing a payment identifier specifying an account to be debited to pay for the selected services;

(d) establishing a service user account that specifies the selected services that the designee can use;

(e) storing in the camera, a service identifier corresponding to the service user account; and

(f) sending the camera to a designee of the customer.

10. The method of claim 9 wherein the camera includes firmware memory, and wherein the service identifier is stored in the firmware memory.

11. The method of claim 9 further including the step of:

(g) capturing an image using the camera; and

(h) forwarding such image to a service provider.

12. The method of claim 11 wherein the customer selected services include the service provider storing the image on a digital media selected by the customer, and shipping the digital media to a designee of the customer.

13. The method of claim 12 wherein the digital media is a CD-R.

14. The method of claim 11 wherein the customer selected services include the service provider storing the image on an Internet accessible digital storage device.

15. The method of claim 11 wherein the customer selected services include the service provider e-mailing the image to at least one e-mail address provided by the customer.

16. The method of claim 4 further including the step of:

(g) storing the images at the designated location for a period of time selected by the customer.

17. A camera for capturing images to be provided to a service provider, comprising:

(a) means for capturing and storing images;

(b) a firmware memory for storing a service identifier which identifies a service provider account, the service provider account specifying services to be provided by the service provider; and

(c) means for providing the captured images and the service identifier to the service provider.

18. The camera of claim 17 wherein the camera is a film camera, the images are captured and stored using photographic film having at least one magnetic track, and the service identifier is recorded on the at least one magnetic track.

19. The camera of claim 17 wherein the camera is an electronic camera including a removable digital memory device, and the images and the service identifier are stored on the removable digital memory device.